



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/990,402	11/21/2001	William K. Slate II	AAA-003	3669

1473 7590 07/27/2005

FISH & NEAVE IP GROUP
ROPES & GRAY LLP
1251 AVENUE OF THE AMERICAS FL C3
NEW YORK, NY 10020-1105

EXAMINER

AUGUSTIN, EVENS J

ART UNIT	PAPER NUMBER
----------	--------------

3621

DATE MAILED: 07/27/2005

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/990,402

Applicant(s)

SLATE ET AL.

Examiner

Evens Augustin

Art Unit

3621

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 11 May 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) See Continuation Sheet is/are pending in the application.
- 4a) Of the above claim(s) 3,31,52,62,90,111,121,149 and 170 is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1,2,4-30,32-51,53-61,63-89,91-110,112-120,122-148,150-169 and 171-177 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| Paper No(s)/Mail Date <u>5/29/03, 9/27/04</u> | 6) <input type="checkbox"/> Other: _____ |

Continuation of Disposition of Claims: Claims pending in the application are 1,2,4-30,32-51,53-61,63-89,91-110,112-120,122-148,150-169 and 171-177.

Response to Amendment

This is in response to an amendment file on May 12th, 2005 for letter for patent filed on November 21st, 2001. In the amendment, claims 1, 29, 45, 49, 50, 60, 88, 104, 108, 109, 119, 147, 163, 167 and 168 have been amended. Claims 3, 31, 52, 62, 90, 111, 121, 149 and 170 have been cancelled. Claims 1-2, 4-30, 32-51, 53-61, 63-89, 91-110, 112-120, 122-148, 150-169, 171-177 are pending in the letter.

Response to Arguments

1. Applicant's arguments filed May 12th, 2005 have been fully considered but they are not persuasive.

Applicant argues that the prior arts fail to teach an inventive concept of providing a dispute resolution, with a case manager/third party that guides the disputing parties through the disputing process. Examiner respectfully disagrees with applicant's characterization of the prior arts' inventive concept of providing a dispute resolution, with a case manager/third party that guides the disputing parties through the disputing process. With regard to the amended claims, Israel et al. teaches computer system that offers dispute resolution through a third party mediator/arbitrator (column 19, lines 1-29), different from the disputing parties. The system guides the disputing parties through the process by allowing them to move seamlessly and uninterrupted through the process (column 19, lines 34-37).

With regard to the types communication/disputes within the system, Israel et al. teaches that the nature of the disputes can be of a bad loan, a business transaction, construction, contract, credit card, foreclosure, labor and employment, landlord/tenant, lender liability, partnership

Art Unit: 3621

agreement, personal injury, professional liability, purchase and sale transaction, rental agreement, intellectual property, subrogation, worker compensation, or any other cause of action recognized by a judicial system, whether in the **United States or abroad** (column 16, lines 38-46).

Although Israel et al. teaches that the dispute can take place in the United States or abroad, Israel et al. did not explicitly describe a system in which the disputing parties are in countries, and the dispute resolution takes into account international or local laws/protocols. However, Cornelius et al. teaches that disputing parties (buyer and seller) can be in different countries (column 1, lines 62-64) and the dispute resolution process can take place with regards to international and foreign laws (column 24, lines 48-64). Therefore, it would have been obvious to one skilled in the art to implement a system in which the disputing parties are in countries, and the dispute resolution takes into account international or local laws/protocols. It would have been obvious to one skilled in the art to implement such system because it would allow for dispute resolution between international entities. Increasingly, businesses are becoming more international, and are involved in international trades. US businesses have operations abroad and vice versa, and having a dispute resolution system that takes into account international or local laws/protocols is necessary in order to serve a global business environment.

Claim Rejections - 35 USC § 102

2. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) The invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

3. Claims 1-12, 15-28, 60-71, 74-87, 119-130, 133-146, 29-44, 88-103 and 147-162, 45-47, 49, 104-106, 108, 163-165, 167, 50-59, 109-118 and 168-177 are rejected under 35 U.S.C. 102(e) as being anticipated by Israel et al. (U.S 6,766,307).

As per claims 1-12, 15-28, 60-71, 74-87, 119-130, and 133-146, Israel et al. discloses a system and method for providing dispute resolution management. The system utilizes software packages (application) (column 28, lines 39-50), and hardware combination (column 8, lines 48-57) for input (keyboard) and display (monitor), as resources to achieve its desired results. The system can:

- Receive dispute resolution management request from users (column 2, line 44)
- Provide the options/features of the dispute resolution management from users (column 3, lines 26-30)
- Manage the dispute resolution management techniques/process (column 5, lines 59-63)
- Receive indication of a selected neutral or third party i.e., mediator or arbitrator (column 19, lines 2-8)
- Allow third party to facilitate the dispute management process (column 19, lines 16-17)

Art Unit: 3621

- Have users as plaintiffs/claimants or defendants/respondents (column 4, line 42)
- Provide users with means to input registration data. This is equivalent to completing an on-line application form (column 9, lines 20-25)
- Receive request for and provide certain features of the dispute resolution management system (column 19, lines 43-47)
- Provide users access with dispute management related information. Users can use electronically search the system using key words to find relevant information (column 19, lines 52-67)
- Provide users with contact information (e-mail) for mediators/arbitrators (column 5, lines 38-42)
- Provide on-line (documents only) or off-line mediation/arbitration (on-call) (column 5, lines 7-9). For online mediation/arbitration, all relevant documents can be transmitted electronically (column 5, lines 29-30, 39-40). For off-line mediation/arbitration, some of the relevant documents can be sent be transmitted, on-line; the rest of the transmission can be done via fax, phone or video (column 5, lines 31-33 & 41-43).
- Provide users with access to mediators/arbitrators, if users choose this particular option (column 17, line 36-40)
- Provide users with additional information regarding the mediator/arbitrator officers (column 20, lines 44-52)
- Receive dispute information from users (column 17, lines 5-7)
- Allow users to submit claim information (column 17, lines 5-7 & 44-50)

- Users can prioritize the viewing of their disputes, based on urgency level (column 18, lines 5-14)
 - Provide dispute information to mediators/arbitrators (column 5, lines 24-31)
 - Provide users with a preset period of time before the system logs them off (column 20, lines 65-66)
 - Provide notifications to the arbitrators/mediators (column 17, lines 41-42)
 - Provide users with discussion area for dispute related discussions via chat rooms and bulletin boards (column 4, line 14)
 - Provide users access to disputes that they have submitted (column 19, lines 43-44)
 - Display all relevant information such as status or any recent activity (postings) of a dispute (column 22 lines 63-65)
 - Receive information from users regarding opposing parties or parties that have a conflict of interest with the dispute (column 16, lines 47-50)
 - Allow users to create profiles (column 4, lines 37-38). The data for a particular profile can be stored and retrieved by users (column 28, lines 31-37) for the purpose of dispute prevention. The data can also be used for dispute resolution (column 4, lines 55-58)
4. As per claims 29-44, 88-103 and 147-162, Israel et al. discloses a system and method for providing dispute resolution management. The system utilizes software packages (application) (column 28, lines 39-50), and hardware combination (column 8, lines 48-57) for input (keyboard) and display (monitor), as resources to achieve its desired results. The system can:
- Receive dispute resolution management request from users (column 2, line 44)

Art Unit: 3621

- Provide users with means to input registration data. This is equivalent to completing an on-line application form (column 9, lines 20-25)
- Provide users with options/features of the dispute resolution management (column 3, lines 26-30)
- Have users as plaintiffs/claimants or defendants/respondents (column 4, line 42)
- Provide users access with dispute management related information. Users can use electronically search the system using key words to find relevant information (column 19, lines 52-67)
- Allow users to choose the dispute resolution management process (column 19, lines 4-5)
- Provide on-line (documents only) or off-line mediation/arbitration (on-call) (column 5, lines 7-9). For online mediation/arbitration, all relevant documents can be transmitted electronically (column 5, lines 29-30, 39-40). For off-line mediation/arbitration, some of the documents can be sent be transmitted, on-line; the rest of the transmission can be done via fax or phone or video (column 5, lines 31-33 & 41-43).
- Provide users with access to mediators/arbitrators if users choose this particular option (column 17, line 36-40)
- Provide users with additional information regarding the mediator/arbitrator officers (column 20, lines 44-52)
- Provide users with fee structure for using the dispute resolution management (column 6, lines 1-9)
- Allow users to modify data (column 12, lines 47-54)

Art Unit: 3621

- Allow users to submit claim information (column 17, lines 5-7 & 44-50). In order to initiate the process, users have to transmit at least one document
- Provide users with a preset period of time before the system logs them off (column 20, lines 65-66)
- Display all relevant information such as status or any recent activity (postings) of a dispute (column 22 lines 63-65)
- Allow users the flexibility not to utilize a process for resolve a dispute (column 18, lines 44-50. Users who are not interested can cancel a mediation/arbitration hearing. The system will send cancellation notices to all parties involved.
- Allow users to create profiles (column 4, lines 37-38)

5. As per claims 45-47, 49, 104-106, 108, 163-165 and 167, Israel et al. discloses a system and method for providing dispute resolution management. The system utilizes software packages (application) (column 28, lines 39-50), and hardware combination (column 8, lines 48-57) for input (keyboard) and display (monitor), as resources to achieve its desired results. The system can:

- Monitor the communication data. The dispute data can also be for retrieval later (column 28, lines 10-14)
- Compare dispute data, base on query languages (column 28, line 21)
- Sort, compile and arrange data to determine a conclusion, based on the fair value of a claim (column 28, lines 23-36)
- Provide a dispute resolution management process to users (column 19, lines 4-5)

Art Unit: 3621

- Users can electronically search the system using key words to find relevant information (column 19, lines 52-67)
- The data for a particular profile can be stored and retrieved by users (column 28, lines 31-37) for the purpose of dispute prevention.
- Provide users with statistics relating to dispute resolution management (column 20, lines 36-37)

6. As per claims 50-59, 109-118 and 168-177, Israel et al. discloses a system and method for providing dispute resolution management. Israel et al.'s invention utilizes software packages (application) (column 28, lines 39-50), and hardware combination (column 8, lines 48-57) for input (keyboard) and display (monitor), as resources to achieve its desired results. Israel et al.'s invention is not limited to any language or currency (column 7, lines 54-60). Therefore, Israel et al.'s invention can be used to resolve international dispute. The system/method can:

- Provide users with options/features of the dispute resolution management (column 3, lines 26-30)
- Provide users with a dispute resolution management process (column 19, lines 4-5)
- Provide on-line (documents only) or off-line mediation/arbitration (on-call) (column 5, lines 7-9). For online mediation/arbitration, all relevant documents can be transmitted electronically (column 5, lines 29-30, 39-40). For off-line mediation/arbitration, some of the relevant documents can be sent be transmitted, on-line; the rest of the transmission can be done via fax or phone or video (column 5, lines 31-33 & 41-43).
- Allow users to create a profile (column 4, lines 37-38).

Claim Rejections - 35 USC § 103

7. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

8. Claims 13-14, 72-73 and 131-132 are rejected under 35 U.S.C. 103(a) as being unpatentable over Israel et al. (US 6,766,307 B1), in view of Murray et al. (U.S 5,023,851).

As per claims 13-14, 72-73 and 131-132, Israel et al. discloses a dispute resolution management method/system that can:

- Receive dispute resolution management request from users (column 2, line 44)
- Provide the options/features of the dispute resolution management from users (column 3, lines 26-30)
- Manage the dispute resolution management techniques/process (column 5, lines 59-63)
- Receive indication of a selected neutral or third party i.e., mediator or arbitrator (column 19, lines 2-8)
- Allow third parties to facilitate the dispute management process (column 19, lines 16-17)

Israel et al. did not explicitly describe a method/system in which the availability and selection of third party mediators/arbitrators is based on an on-line calendar. However, Murray et al describes a method for presenting electronic calendar information in an interactive

Art Unit: 3621

information handling system, which employs a calendar program for displaying events and time slots available for the next event (column 9, lines 6-10). Therefore, it would have been obvious for one of ordinary skill in the art at the time of the applicant's invention to construct a system that would utilize an on-line calendar for the availability of mediators/arbitrators. It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to implement an on-line, in order to minimize scheduling conflicts.

9. Claims 47-48, 106-107 and 165-166 are rejected under 35 U.S.C. 103(a) as being unpatentable over Israel et al. (US 6,766,307 B1), in view of Sloo (US 5,895,450).

As per claims 48, 107 and 166, Israel et al. discloses a dispute resolution management method/system that can:

- Receive dispute resolution management request from users (column 2, line 44)
- Provide the options/features of the dispute resolution management from users (column 3, lines 26-30)
- Manage the dispute resolution management techniques/process (column 5, lines 59-63)
- Receive indication of a selected neutral or third party i.e., mediator or arbitrator (column 19, lines 2-8)
- Allow third parties to facilitate the dispute management process (column 19, lines 16-17)

Israel et al. did not explicitly describe a method/system in which users are giving warning regarding the likelihood of a particular dispute's outcome and prevention. However, Sloo describes a method and apparatus for handling complaints, which predicts the outcome of a

Art Unit: 3621

dispute (column 10, lines 56-54). The system would give plaintiffs the likely resolution of a dispute before the dispute actually occurs (column 10, lines 50-53). The system would also recommend actions to be taken, in order to prevent disputes (column 10, lines 66-67, column 11, lines 1-2, column 17, lines 52-57). Therefore, it would have been obvious for one of ordinary skill in the art at the time of the applicant's invention to construct a system that indicates the likelihood of a particular dispute's outcome. It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to implement such system, in order for users to gauge their success level for a particular dispute (column 11, lines 1-5). It would encourage good conduct and corporation between the parties during the course of the disputes (column 2, lines 19-20).

10. Claims 53, 112 and 171 are rejected under 35 U.S.C. 103(a) as being unpatentable over Israel et al. (US 6,766,307 B1), in view of Eaglesham et al. (Financial times, October 16, 2000, pg 25, "Online arbitration business law").

As per claims 53, 112 and 171, Israel et al. discloses a dispute resolution management method/system that can:

- Receive dispute resolution management request from users (column 2, line 44)
- Provide the options/features of the dispute resolution management from users (column 3, lines 26-30)
- Manage the dispute resolution management techniques/process (column 5, lines 59-63)
- Receive indication of a selected neutral or third party i.e., mediator or arbitrator (column 19, lines 2-8)
- Allow third parties to facilitate the dispute management process (column 19, lines 16-17)

Israel et al. did not explicitly describe a method/system in which provides international arbitration clauses. However, in the Financial Times article, Eaglesham et al. talked about a law firm www.lovells.com, giving free online arbitration agreements services, aimed at anyone who wants information or drafting help for arbitration clauses in international commercial contracts. Therefore, it would have been obvious for one of ordinary skill in the art at the time of the applicant's invention to construct a system that provides international arbitration clauses. It would have been obvious to one of ordinary skill in the art at the time of the applicant's invention to implement such system, in order to enforce international arbitration laws. International arbitration clauses enable users to have their disputes decided by a neutral tribunal, rather than national courts.

11. Claims 50-59, 109-118, 168-177 are rejected under 35 U.S.C. 103(a) as being unpatentable over Israel et al. (US 6,766,307 B1), in view of Cornelius et al. (US 6629081).

As per claims 50-59, 109-118, 168-177, Israel et al. have previously been disclosed.

Although Israel et al. teaches that the dispute can take place in the United States or abroad, Israel et al. did not explicitly describe a system in which the disputing parties are in countries, and the dispute resolution takes into account international or local laws/protocols. However, Cornelius et al. teaches that disputing parties (buyer and seller) can be in different countries (column 1, lines 62-64) and the dispute resolution process can take place with regards to international and foreign laws (column 24, lines 48-64). Therefore, it would have been obvious to one skilled in the art to implement a system in which the disputing parties are in countries, and the dispute resolution takes into account international or local

laws/protocols. It would have been obvious to one skilled in the art to implement such system because it would allow for dispute resolution between international entities. Increasingly, businesses are becoming more international, and are involved in international trades. US businesses have operations abroad and vice versa, and having a dispute resolution system that takes into account international or local laws/protocols is necessary in order to serve a global business environment.

Conclusion

12. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Art Unit: 3621

13. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Evens Augustin whose telephone number is 571-272-6860. The examiner can normally be reached on Monday thru Friday 8 to 5 pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Jim Trammel can be reached on 571-272-6712.

Any response to this action should be mailed to:

Commissioner for Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Any inquiry of a general nature or relating to the status of this application should be directed to the Group receptionist whose telephone number is 571-272-6584.

Evens J. Augustin
July 8, 2005
Art Unit 3621

Evens J. Augustin
Primary Examiner
3621